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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/666,816	09/18/2003	Susann Marie Keohane	AUS920030442US1	8940
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IBM CORP. (AUS) C/O MUNSCH HARDT KOPF & HARR, P.C. 3800 LINCOLN PLAZA 500 N. AKARD STREET DALLAS, TX 75201-6659			EXAMINER DAILEY, THOMAS J	
			ART UNIT 2152	PAPER NUMBER
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/666,816	<b>Applicant(s)</b> KEOHANE ET AL.	
	<b>Examiner</b> THOMAS J. DAILEY	<b>Art Unit</b> 2152	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 06 June 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,3-11,13-21,23-31 and 33-40 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3-11,13-21,23-31 and 33-40 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. Claims 1, 3-11, 13-21, 23-31, and 33-40 are pending.
2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on June 6, 2008 has been entered.

### ***Response to Arguments***

3. The 35 USC 112 second paragraph rejections directed at claims 4-10, 14-16, 20, 24-26, 30, 34-36, and 40 have been withdrawn in view of the entered amendment of June 6, 2008.
4. Applicant's arguments filed June 6, 2008 with respect to claims 1, 11, 21, and 31 (specifically the amended subject matter, i.e. "enabling the sender, *in response to determining that one of the recipients from the list of recipients has accessed the stored e-mail message* and using the notification message, to preclude one of the recipients from the list of recipients *that have not yet accessed the stored e-mail message* from accessing the stored e-mail message") have been

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considered but are moot in view of the new ground(s) of rejection. See the 35 USC 112 rejections below and specification objection.

5. Applicant's arguments filed June 6, 2008 with respect to the prior art rejections of claims 1, 3-11, 13-21, 23-31, and 33-40 have been fully considered but they are not persuasive.
6. The applicant argues specifically with respect to claim 7 that Bronge (EP Pub. No. 1,087,321) does not teach "displaying the list of recipients and a copy of the stored e-mail message to the sender wherein all recipients from the list of recipients that are determined to have already accessed the stored e-mail message are displayed in a distinguishing fashion from recipients that have not already accessed the stored e-mail message." The applicant contends Brogne teaches that a sender of an email message may retract or modify the e-email message so long as the e-mail message has not yet been accessed by anyone of the addresses.
7. The examiner disagrees. Bronge discloses that a sender of an email message may retract or modify the mail message so long as the email message has *not yet been accessed by all of the addresses* (column 5, lines 52-54 and column 6, lines 7-19, as long as status storage does not equal null (i.e. everyone that the email has been addressed to has accessed the message) the sender may modify

the message), not simply anyone of the addresses. The examiner further notes that Mileski (US Pat. 5,930,471) was relied upon for disclosing displaying the list of recipients and a copy of the stored e-mail message to the sender wherein all recipients from the list of recipients that are determined to have already accessed the stored e-mail message are displayed in a distinguishing fashion from recipients that have not already accessed the stored e-mail message as outlined in the below rejections of the claims.

### ***Specification***

8. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o).  
Correction of the following is required:

9. The amended independent claims 1, 11, 21, and 31 substantially recite, "enabling the sender, *in response to determining that one of the recipients from the list of recipients has accessed the stored e-mail message* and using the notification message, to preclude one of the recipients from the list of recipients *that have not yet accessed the stored e-mail message* from accessing the stored e-mail message," (e.g. claim 1, lines 13-17, emphasis added). The applicant has pointed to page 14, line 23 to page 15, line 3 of the specification as providing support for the claimed subject matter. The examiner could not find support for that claim language in those portions of the specification or anywhere in the

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specification. Specifically, enabling the sender to preclude one of the recipients from the list of recipients that have not yet accessed the stored e-mail message from accessing the stored e-mail message does not appear to be responsive to the determination that one of the recipients has accessed the stored e-mail message.

***Claim Rejections - 35 USC § 112***

10. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

11. Claims 1, 3-6, 11, 13-16, 21, 23-26, 31, and 33-36 are rejected under 35

U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

12. The amended independent claims 1, 11, 21, and 31 substantially recite,

*"enabling the sender, in response to determining that one of the recipients from the list of recipients has accessed the stored e-mail message and using the notification message, to preclude one of the recipients from the list of recipients that have not yet accessed the stored e-mail message from accessing the stored*

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e-mail message," (e.g. claim 1, lines 13-17, emphasis added). The applicant has pointed to page 14, line 23 to page 15, line 3 of the specification as providing support for the claimed subject matter. The examiner could not find support for that claim language in those portions of the specification or anywhere in the specification. Specifically, enabling the sender to preclude one of the recipients from the list of recipients that have not yet accessed the stored e-mail message from accessing the stored e-mail message does not appear to be responsive to the determination that one of the recipients has accessed the stored e-mail message.

13. Claims 3-6, 13-16, 23-26, and 33-36 are rejected due to their dependence on the above rejected claims.

***Claim Rejections - 35 USC § 103***

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. Claims 1, 3, 7-9, 11, 13, 17-19, 21, 23, 27-29, 31, 33, and 37-39 are rejected under 35 U.S.C. 103(a) as being unpatentable by Brogne et al (EP Pub. No.

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1,087,321), hereafter "Brogne," in view of Milewski et al (US Pat. 5,930,471), hereafter "Milewski."

16. As to claim 1, Brogne discloses a method of rescinding previously transmitted e-mail messages by a sender, the message being addressed to a list of recipients (Abstract), the method comprising the steps of:

- storing an e-mail message on a computing system (column 2, lines 13-19);
- generating a notification message, the notification message for allowing recipients from the list of recipients to access the e-mail message (column 2, lines 13-19 and column 3, lines 54-57);

- sending the notification message to the recipients from the list of recipients (column 2, lines 15-19);

- determining whether one of the recipients from the list of recipients has accessed the stored e-mail message (column 5, lines 52-54 and column 6, lines 7-9, the status storage keeps track of how many recipients have accessed the message as disclosed in column 6, lines 31-37); and

- enabling the sender, in response to determining that one of the recipients from the list of recipients has accessed the stored e-mail message and using the notification message, to preclude one of the recipients from the list of recipients that have not yet accessed the stored e-mail message from accessing the stored e-mail message (column 3, lines 32-41).



But, Brogne does not explicitly disclose generating and sending a notification message to the sender and that notification message enabling the preclusion of e-mail access by the receipts. However, Brogne does disclose the sender has access to the e-mail message as long as all recipients have not retrieved it (Fig. 3); Brogne simply does not explicitly state that a notification message gives the sender the means to do so.

However, Milewski discloses generating and sending a notification message to the sender and intended recipients of a message and that notification message enabling the sender to perform operations on the stored message (column 8, lines 53-64 and column 6, lines 25-33)).

Since both Brogne and Milewski teach methods of accessing previously sent messages by the sender, it would have been obvious to one of ordinary skill in the art at the time of the invention to substitute one method of providing the sender with access to the message with the other thereby achieving the predictable result of enabling the sender to rescind a previously sent message.

17. As to claim 7, Brogne discloses a method of modifying a previously transmitted e-mail message by a sender, the message being addressed to a list of recipients (Abstract), the method comprising the steps of:

storing the e-mail message on a computing system (column 2, lines 13-19);

generating a notification message, the notification message for allowing recipients from the list of recipients and the sender access the stored e-mail message (column 2, lines 13-19 and column 3, lines 54-57);

sending the notification message to the recipients from the list of recipients (column 2, lines 15-19); and

enabling the sender to modify the stored e-mail message (column 3, lines 32-41), including:

determining whether at least one recipient from the list of recipients has already accessed the stored e-mail message (column 5, lines 52-54 and column 6, lines 7-9, the status storage keeps track of how many recipients have accessed the message);

allowing the sender to modify the displayed copy of the stored e-mail message and to send the modified copy to the recipients that have not already accessed the stored e-mail message (column 6, lines 7-19); and

replacing the stored e-mail message with the modified copy once the modified copy is sent to the recipients that have not already accessed the stored e-mail message (column 6, lines 7-19).

But, Brogne does not explicitly disclose generating and sending a notification message to the sender and that notification message enabling the modification of a previously sent message. However, Brogne does disclose the sender has access to and can modify the e-mail message as long as all recipients have not

retrieved it (Fig. 3); Brogne simply does not explicitly state that a notification message gives the sender the means to do so.

Further, Brogne is silent with regards to displaying the list of recipients and a copy of the stored e-mail message to the user wherein all recipients from the list of recipients that are determined to have already accessed the stored e-mail message are displayed in a distinguishing fashion from recipients that have not already accessed the stored e-mail message.

However, Milewski discloses generating and sending a notification message to the sender and intended recipients of a message and that notification message enabling the sender to perform operations on the stored message (column 8, lines 53-64 and column 6, lines 25-33)) and further displaying the list of recipients and a copy of the stored e-mail message to the sender wherein all recipients from the list of recipients that are determined to have already accessed the stored e-mail message are displayed in a distinguishing fashion from recipients that have not already accessed the stored e-mail message (Fig. 6 and column 8, lines 9-24).

Since both Brogne and Milewski teach methods of accessing previously sent messages by the sender, it would have been obvious to one of ordinary skill in the art at the time of the invention to substitute one method of providing the sender with access to the message, including Milewski's notification of what

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recipients have accessed the message, with the other thereby achieving the predictable result of enabling the sender to modify a previously sent message and giving the sender more information with regard to the previously sent message (i.e. what recipients have or have not accessed the message).

18. As to claims 11, 21, and 31, they are rejected by the same rationale set forth in claim 1's rejection.

19. As to claims 17, 27, and 37, they are rejected by the same rationale set forth in claim 7's rejection.

20. As to claims 3, 8, 13, 18, 23, 28, 33, and 38, Brogne and Milewski disclose the invention substantially with regard to the parent claim, and further disclose discloses the e-mail message having a text portion, the sender being allowed to modify the text portion (Brogne, column 3, lines 39-41).

21. As to claims 9, 19, 29, and 39 Brogne and Milewski disclose the invention substantially with regard to the parent claim, and further disclose discloses the e-mail message has a list of recipients, the list of recipients being modified by the sender (Brogne, column 3, lines 32-41).

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22. Claims 4-6, 10, 14-16, 20, 24-26, 30, 34-36, and 40 are rejected under 35

U.S.C. 103(a) as being unpatentable over Brogne and Milewski as applied to claims 1, 7, 11, 17, 21, 27, 31, and 37 above, and further in view of what is well known in the art.

23. As to claim 4, 10, 14, 20, 24, 30, 34, and 40, Brogne and Milewski disclose the invention substantially with regard to the parent claim, and further disclose the notification message for automatically accessing the e-mail message being a password (Brogne, column 5, lines 21-24).

Although, Brogne does not explicitly disclose that the password is a public key which decrypts the stored email, Official Notice is taken (MPEP 2144.04) that encrypting emails using a public key password was a well-known use of email access passwords at the time the applicant's invention was made, and is deployed to enhance security of the stored emails. Thus, it would have been obvious to one of ordinary skill in the art at the time of the invention to take advantage of a well known practice to modify the teachings of Brogne and Milewski in order to achieve such benefits.

24. As to claims 5, 15, 25, and 35, Brogne and Milewski disclose the invention substantially with regard to the parent claims 4, 14, 24, and 34, and further

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disclose the computing system is the computing system on which the stored e-mail message was composed (Brogne, column 4, lines 12-26).

25. As to claims 6, 16, 26, and 36, Brogne and Milewski disclose the invention substantially with regard to the parent claims 4, 14, 24, and 34, and further disclose the computing system is a server, the server generating and sending the notification message to the recipients and sender (Brogne, column 2, lines 12-19).

### ***Conclusion***

26. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas J. Dailey whose telephone number is 571-270-1246. The examiner can normally be reached on Monday thru Friday; 9:00am - 5:00pm.

27. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bunjob Jaroenchonwanit can be reached on 571-272-3913. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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28. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/T. J. D./  
Examiner, Art Unit 2152

/Kenny S Lin/

Primary Examiner, Art Unit 2152